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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,574	11/03/2000	Vernon M. Ingram	M0656/7060	6165

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EXAMINER

CELSA, BENNETT M

ART UNIT	PAPER NUMBER
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1627

DATE MAILED: 04/11/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

file copy

Office Action Summary

Application No.
09/706,574

Applicant(s)
Ingram et al.

Examiner
Bennett Celsa

Art Unit
1627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9 and 29-49 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 9 and 29-49 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Claims 9 and 29-49 are currently pending.

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 9 drawn to peptides, classified in class 530, subclass 300+.
 - II. Claims 29-31, drawn to a competitive binding assay for screening a candidate pharmacological agent, classified in class 436, subclass 2+.
 - III. Claims 32-39, drawn to a first cellular assay for screening a candidate pharmacological agent (using a calcium-sensitive compound, classified in class 435, subclass 7.1 +.
 - IV. Claims 40-49, drawn to a second cellular assay for screening a candidate pharmacological agent (using a "potentiomeric compound").

The inventions are distinct, each from the other because:

2. Inventions (I) and (II, III or IV) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as in generating antibodies for affinity purification or for

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therapeutic use using as pharmaceutical compositions as included within Groups I-V as compared to diagnostic use or as in use in assay as in Groups Vi or Vii..

3. Inventions II, III or IV are directed to patentably distinct assay methods which are directed to different method steps and comprise the use of different reactants and experimental protocol. For Example, Groups III and IVi employs the use of a cell not utilized in the Group II. Additionally, the methods of Group III and IV employs different reagents (e.g. calcium sensitive vs. potentiomeric compound). Further the methods of Groups II, III and IV are not disclosed as capable of use together and they have different modes of operation, different functions for achieving the screening of candidate drug compounds.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and different required manual and computer searches, restriction for examination purposes as indicated is proper.

Upon selecting one of the above mentioned inventions, the following Election of Species is required:

ELECTION OF SPECIES

A. Groups I-II are directed to a plurality of patentably distinct "peptides" or "decoy peptides";

B. Groups II-IV are directed to a plurality of patentably distinct candidate pharmacological agents which include (but are not limited to) peptides, non-NMDA channel antagonists or small organic molecules

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The above groups of compounds differ structurally and biochemically and/or by means of manufacture and/or use; require different and burdensome searches; and as such constitute patentably distinct subject matter.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species (e.g. a specific compound) from among the above categories A-D (as applicable) for prosecution on the merits to which the claims shall be restricted if no proper generic claim is finally held to be allowable. If a structure of the elected compound is not in the specification, the Examiner respectfully requests the submission of a structure in order to facilitate searching.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a proper generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

General information regarding further correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Celsa whose telephone number is (703) 305-7556.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat (art unit 1627), can be reached at (703)308-0570.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Bennett Celsa (art unit 1627)

April 9, 2002

**BENNETT CELSA
PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read 'Bennett Celsa', is written over the printed name and title.